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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,180	09/03/2003	Mauro Dresti	81230.68US2	5022

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EXAMINER

YANG, CLARA I

ART UNIT PAPER NUMBER

2635

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/654,180

Applicant(s)

DRESTI ET AL.

Examiner

Clara Yang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION***Specification*

1. The disclosure is objected to because of the following informalities: On page 1, line 5, insert "now Patent No. 6,642,852" after "March 1, 2002".

Appropriate correction is required.

*Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 - 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 7, 8, 10 - 18 and 20 of U.S. Patent No. 6,642,852. Although the conflicting claims are not identical, they are not patentably distinct from each other as follows:

Claims in Application No. 10/654180	U.S. Patent No. 6,642,852
Claims 1, 10, and 19 - ♦ accepting input into the remote control which defines a macro command sequence, the macro command sequence including a command for causing the appliance to enter into the desired power state;	See Col. 11, lines 8 - 11, 19 - 23, and 49 - 52; Col. 12, lines 26 - 29; Col. 13, lines 17 - 21; and Col. 14, lines 20 - 24

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<ul style="list-style-type: none"> <li>◆ receiving at the remote control from a power monitor associated with the appliance a current power state of the appliance;</li> <li>◆ maintaining within a memory of the remote control data indicative of a current power state of the appliance;</li> <li>◆ comparing within the remote control the current power state to the desired power state; and</li> <li>◆ when it is determined that the current power state is the desired power state, inhibiting the remote control from transmitting the command for causing the appliance to enter into the desired power state when the macro command sequence is executed by the remote control.</li> </ul>	<p>See Col. 11, lines 12 - 15; Col. 12, lines 30 - 34; and Col. 13, lines 23 - 27</p> <p>See Col. 11, lines 16 - 18; Col. 12, lines 35 - 38; and Col. 13, lines 28 - 33</p> <p>See Col. 11, lines 33 - 36; Col. 12, lines 55 - 59; and Col. 14, lines 2 - 5</p> <p>See Col. 11, lines 33 - 36; Col. 12, lines 59 - 65; and Col. 14, lines 5 - 10</p>
Claims 2, 11, 20	See Col. 11, lines 49 - 52 and Col. 14, lines 20 - 24
Claims 3, 12	See Col. 12, lines 1 - 9; Col. 12, lines 66 - 67; and Col. 14, lines 11 - 19
Claims 4, 13	See Col. 13, lines 7 - 9
Claims 5, 14, 21	See Col. 11, lines 42 - 44 and Col. 13, lines 10 - 12
Claims 6, 15	See Col. 11, lines 8 - 11; Col. 12, lines 26 - 29; and Col. 13, lines 17 - 21
Claims 7, 16	See Col. 11, lines 16 - 18; Col. 12, lines 35 - 38
Claims 8, 17, 22	See above for claims 1, 10, and 19
Claims 9, 18, 23	See Col. 11, lines 53 - 56 and Col. 14, lines 38 - 42
<p>Claim 24</p> <p>A system for controlling the operation of an appliance, the system comprising:</p> <ul style="list-style-type: none"> <li>◆ a power monitor having a first wireless communication module associated with the appliance; and</li> <li>◆ a remote control having a second wireless communication module for transmitting</li> </ul>	<p>See Col. 12, lines 14 - 19</p> <p>See Col. 11, lines 8 - 11 and Col. 12, lines 19 - 24</p>

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<p>one or more commands to the appliance and a third wireless communication module for communicating with the first wireless communication module of the power module;</p> <p>♦ wherein the remote control has programming for accepting input into the remote control which defines a macro command sequence, the macro command sequence including a command transmittable via the second wireless module for causing the appliance to enter into a desired power state; receiving at the remote control via the third wireless communication module from the first wireless communication module of the power monitor a current power state of the appliance; comparing within the remote control the current power state to the desired power state; and when it is determined that the current power state is the desired power state, inhibiting the remote control from transmitting via the second wireless communication module the command for causing the appliance to enter into the desired power state when the macro command sequence is executed by the remote control.</p>	<p>See Col. 11, lines 8 - 41 and 49 - 52; and Col. 12, lines 24 - 65</p>
Claim 25	See above for claims 2, 11, and 20
Claim 26	See above for claims 3 and 12 and Col. 12, lines 22 - 24
Claim 27	See Col. 13, lines 7 - 9
Claim 28	See Col. 13, lines 10 - 12
Claim 31	See above for claims 6 and 15
Claim 32	See above for claims 7 and 16
Claim 33	See above for claims 8, 17, and 22 and Col. 12, lines 19 - 22
Claim 34	See above for claims 9, 18, and 23

Though U.S. Patent No. 6,642,852 omits claiming that the second and third wireless communication modules comprise the same module as called for in claim 29, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the second and third communication modules such that they are contained in one communication module since it has been held that it would have been obvious to use a one piece construction instead of a two-piece construction. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.")

Regarding claim 30, U.S. Patent No. 6,642,852 also omits claiming that the remote control's second wireless communication module is an RF module. However, the third wireless communication module is an RF module. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the second wireless communication module such that it is an RF module since RF propagates better than IR.

#### *Claim Objections*

4. Claims 8, 17, 22, and 33 are objected under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 1, 10, 19, and 24 already call for "inhibiting the remote control from transmitting the command for causing the appliance to

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enter the desired power state when the macro command sequence is executed by the remote control." In other words, the remote control transmits the macro command sequence without the power command.

*Allowable Subject Matter*

5. Claims 1 - 34 would be allowable if a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) is used to overcome the actual rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a handheld remote control that (1) accepts a macro command sequence that includes a command for causing an appliance to enter a desired power state, (2) receives the appliance's current power state, which is transmitted by a power monitor associated with the appliance, (3) compares the appliance's current power state to the desired power state, and (4) refrains from transmitting a power command if the appliance is already in the desired power state while transmitting the rest of the macro command sequence.

U.S. Patent No. 6,496,927 (McGrane et al.) teaches a system and method similar to the claimed invention. However, there are three major differences. First, claims 1, 10, and 19 require that a remote control have a readable media that enables the remote control to perform the above-mentioned steps. McGrane, on the other hand, teaches that such readable media resides in master control unit 11, not hand-held remote 12. Secondly, McGrane's system, as shown in Fig. 1, has (1) power sensor 21, (2) hand-held remote 12, and (3) master control unit 11. Though McGrane's power sensor 21 has a wireless communication module for communicating

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with device/appliance 17, McGrane's remote 12 is only able to transmit one or more commands to master control unit 11 and is unable to receive device 17's current power state from power sensor 21, thus failing to read on claim 24. Finally, McGrane teaches that master control unit 11 is able to refrain transmitting a power command if the appliance is already in the desired power state but fails to disclose that master control unit 11 transmits the rest of the macro command sequence after inhibiting the power command transmission.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (571) 272-3062. The examiner can normally be reached on 8:30 AM - 7:00 PM, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CY

  
BRIAN ZIMMERMAN  
PRIMARY EXAMINER